

**REMARKS**

**I. Status of Claims**

Claims 1 and 14 are amended to incorporate the content of the chelate, the organic acid and the phosphate ester-based compound, relative to the weight of the tin-doped indium oxide fine particles. Support for the amendments can be found at Examples 1a-1c, 2-4 and 10-12 of the specification.

Claims 27-30 are added. Claims 27 and 28 are supported by the specification at Examples 1a-1c, 2-4 and 10-12, while claims 29 and 30 are supported by original claims 18 and 24, respectively.

No new matter is added. Accordingly, Applicants respectfully request entry and consideration of the Amendment. Upon entry of the Amendment, claims 1-5 and 9-30 will be pending.

**II. Statement of Substance of Interview**

In a telephonic Interview conducted on December 23, 2010, Applicants' representative and Examiner Nakarani discussed the § 112, first paragraph and § 103(a) rejection of the pending claims. The Examiner clarified the basis of the § 112, first paragraph rejection. Possible claim amendments to overcome the §§ 112 and 103 rejections were also discussed. No agreement was reached.

**III. Response to Claim Rejection Under 35 U.S.C. § 112, first paragraph**

Claims 1-5 and 9-26 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Applicants respectfully traverse, at least for the following reasons.

Present Claim 1 is directed to a dispersion of tin-doped indium oxide fine particles, wherein the contents of the tin-doped indium oxide fine particles and the dispersion stabilizer fulfill the following features:

- (a) the concentration of the tin-doped indium oxide fine particles is from 10 to 60% by weight;
- (b) the content of the dispersion stabilizer is from 6 to 20.7% by weight; and,
- (c) the content of the chelate is in a range of 3.3 to 30 parts by weight, the content of the organic acid is in a range of 6.0 to 20.3 parts by weight, and the content of the phosphate ester-based compound is in a range of 6.7 to 16.7 parts by weight, relative to 100 parts by weight of the tin-doped indium oxide fine particles, respectively.

Applicants submit that the amendments to claim 1 clarifies the content of chelate, organic acid and phosphate ester-based compound, with respect to 100 parts by weight of the tin-doped indium oxide fine particles, as supported by Examples 1a-1c, 2-4 and 10-12 of the specification.

At pages 2-4 of the Office Action dated October 18, 2010, the Examiner states that the specification lacks written description support for the following two cases:

- (1) in which 20.7% by weight of the dispersion stabilizer and 10% by weight of the tin-doped indium oxide fine particles are included; and
- (2) in which 6% by weight of the dispersion stabilizer and 60% by weight of the tin-doped indium oxide fine particles are included.

Applicants respectfully submit that in view of the present amendment to Claim 1, the above two cases relied upon by the Examiner are not included in the scope of claim 1, obviating the § 112, first paragraph rejection of claim 1, and dependent claims thereof. As a result, the contents of the tin-doped indium oxide fine particles and the dispersion stabilizer that fulfill all

of the features (a) to (c) are supported by the specification, and no new matter is included in claims 1 to 26.

Regarding Claim 27, added in the present Amendment, the contents of the tin-doped indium oxide fine particles and the dispersion stabilizer have the following features:

- (a) the concentration of the tin-doped indium oxide fine particles is from 10 to 60% by weight;
- (b') the total content of the chelate, the organic acid, and phosphate ester-based compound is in a range of 26.7 to 60 parts by weight relative to 100 parts by weight of the tin-doped indium oxide fine particles; and,
- (d) the content of the organic acid is in a range of 2 to 8% by weight, and the content of the phosphate ester-based compound is in a range of 1 to 6% by weight, respectively.

Claim 27 is supported by Examples 1a to 1c, 2 to 4 and 10 to 12 of the specification.

The above described cases (1) and (2) that the Examiner indicates lacks written description support in the specification are not included in the scope of claim 27. As a result, the contents of the tin-doped indium oxide fine particles and the dispersion stabilizer that fulfill all of the features (a), (b') and (d) are supported by the specification, and no new matter is included. Thus, claim 27, and dependent claims thereof, satisfies the requirements of 35 U.S.C. § 112, first paragraph.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the § 112, first paragraph rejection of claims 1-5 and 9-30.

**IV. Response to Claim Rejection Under 35 U.S.C. § 103(a)**

Claims 1-5 and 9-26 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kondo (U. S. Patent No. 6,329,061 B2) in view of Kobata et al (U. S. Patent No. 6,673,456 B1) and Mont et al (U. S. Patent No. 4,027,069). The Examiner stated that the

recited contents of tin-doped indium oxide (ITO), chelate, carboxylic acid and polyphosphate ester salt in the Reference Table at page 14 of the arguments filed July 22, 2010 are disclosed by Kobata for an interlayer.

Applicants respectfully traverse, at least for the following reasons.

In Example 1 of Kobata, 40 parts by weight of 3GO, 0.3 parts by weight of ITO powder, polyphosphoric acid ester salt, and 0.1 part by weight of acetylacetone as dispersants are mixed to prepare an ITO dispersion in plasticizer (corresponding to the dispersion of tin-doped indium oxide fine particles of the present invention). See, e.g., column 19, lines 37-53 of Kobata. The value recited in the column “addition amount of ITO” in Table 3 of Kobata is 0.3. Thus, a person of ordinary skill in the art would understand that Tables 3, 5, and 7 of Kobata show constituents and their contents of ITO dispersions in plasticizers (corresponding to the dispersion of tin-doped indium oxide fine particles of the present invention). In addition, from the description after Example 2, a person of ordinary skill in the art would understand that the types and the amounts of the compounds to be added are changed when preparing the ITO dispersions in plasticizers.

In view of the above, the Reference Table at page 14 of the arguments filed July 22, 2010 was prepared based on the constituents and their contents of the ITO dispersions in plasticizers in Examples of Kobata, and not based on constituents and their contents of interlayers of Kobata.

Accordingly, as discussed in the arguments filed July 22, 2010, the dispersion of tin-doped indium oxide fine particles that fulfills the features of the presently claimed invention is not exemplified in Kobata.

In particular, in Kobata, the contents of the three components of the dispersion stabilizer are not clearly disclosed. Therefore, a person skilled in the art would not be motivated to fulfill

all of the features (a) to (c) of claim 1 or all of the features (a), (b') and (d) of claim 27 based on the disclosure of Kobata. Accordingly, the presently claimed invention is patentable over Kobata.

Neither Kondo nor Mont discloses or suggests all of the features (a) to (c) of claim 1 and all of the features (a), (b') and (d) of claim 27.

As a result, even if, *arguendo*, the inventions of Kobata, Kondo and Mont were to be combined, a person of ordinary skill in the art would not have a reasonable expectation of success of arriving at all of the features (a) to (c) of claim 1 and all of the features (a), (b') and (d) of claim 27.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103 rejection of claims 1-5 and 9-30.

#### Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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